

REMARKS

By the present amendment in the accompanying RCE, claims 4 - 13 have been retained without amendment and new claims 14 - 23 have been presented wherein claims 14 and 18 are new independent claims corresponding somewhat to the features recited in present independent claim 4 and applicants submit that all claims patentably distinguish over the cited art, as will be discussed below.

Request for Interview

Prior to the filing of this RCE the undersigned attorney contacted the Examiner Mr. Chen, to request scheduling of an interview. Due to unavailability of Mr. Chen, it was determined that the filing of an RCE with additional claims would be appropriate and upon Mr. Chen becoming available, an interview would be conducted. Thus, applicants request that, prior to taking action in this application, the Examiner contact the undersigned attorney to schedule an interview.

The rejection of claims 4, 7, 9, 10 and 13 under 35 USC 103(a) as being unpatentable over Crue et al (US 6,043,959) in view of Hong et al (US 6,423,430), Han et al (US 6,024,886), Cai (US 6,191,911), and Sedlmayr et al (US 5,761,166); and the rejection of claims 6, 8, 11 and 12 under 35 USC 103(a) as being unpatentable over the aforementioned combination of art further in view of Linliu et al (US 5,773,199), Shiratori et al (US 6,180,208), Huber (US 6,178,144) and Yamashita et al (US 6,215,609), respectively; such rejections are traversed insofar as they are applicable to the previous claims and the newly added claims, and reconsideration and withdrawal of the rejections are respectfully requested.

As to the requirements to support a rejection under 35 USC 103, reference is made to the decision of In re Fine, 5 USPQ 2d 1596 (Fed. Cir. 1988), wherein the court pointed out that the PTO has the burden under '103 to establish a prima facie case of obviousness and can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. As noted by the court, whether a particular combination might be "obvious to try" is not a legitimate test of patentability and obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. As further noted by the court, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

Furthermore, such requirements have been clarified in the decision of In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 2002) wherein the court in reversing an obviousness rejection indicated that deficiencies of the cited references cannot be remedied with conclusions about what is "basic knowledge" or "common knowledge".

The court pointed out:

The Examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is immaterial to patentability, and could not be resolved on subjected belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher."... Thus, the Board must not

only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion. (emphasis added)

Applicants note that in rejecting claim 4 and some of the dependent claims, the Examiner has combined five patents and for the other dependent claims has proposed a combination of six patents. Thus, the Examiner has recognized that the primary reference to Crue et al fails to disclose or teach the claimed invention and has picked bits and pieces from other cited art in an attempt to reconstruct the claimed invention. Applicants submit that the Examiner has engaged in a hindsight reconstruction attempt utilizing the principle of "obvious to try" which is not the standard of 35 USC 103 (see, In re Fine, surpa) and has provided motivation and a reconstruction utilizing what applicant has taught against the teacher (see, In re Lee, supra), which applicants submit is not proper.

Applicants note that the independent claims of this application recite the features of a magnetic recording and reading device of a particular construction including a magnetic head having a recording head with a magnetic core of a magnetic core length l_1 of not more than 35 μm together with a reading head having a read element with a track width of not more than 0.9 μm , a RW - IC together with other features which, provide a relationship, as recited, to enable a magnetic recording and reading device to operate in the manner set forth.

In rejecting the claims over the combination of the cited art, the Examiner recognizes the deficiencies of Crue et al, as well as deficiencies with respect to the individual secondary references, but merely picks and chooses from the secondary references, contending that one of ordinary skill in the art would have been motivated to effect the combination with Crue et al. Applicants submit that the Examiner has engaged in a hindsight reconstruction, and the fact that it takes a

minimum of five patents in an attempt to provide the structural features, as set forth in claim 4 and the dependent claims, for example, is evidence of the lack of motivation of Crue et al to provide such features, as claimed. Thus, applicants submit that all claims patentably distinguish over Crue et al taken alone or in combination with the other cited art in the sense of 35 USC 103 and should be considered allowable thereover.

With respect to Hong et al, Han et al, Cai and Sedlmayr et al, as is apparent from the description by the Examiner, and the individual cited art, these references while having individual features, do not suggest the other features which are clearly absent in the individual patents. Thus, applicants submit that while the Examiner contends that it would be obvious to combine the patents in the manner set forth, in an attempt to reconstruct the claimed invention, applicants submit that contrary to the Examiner's position, there is no motivation to effect the combination as suggested, other than to reconstruct the claimed invention and each of the cited art achieve its desired characteristics of the inventions disclosed without the combination of features, as claimed. Accordingly, applicants submit that the independent and dependent claims of this application patentably distinguish over the proposed combination of references as effected by the combination of five patents as well as the combination of six patents, as suggested by the Examiner. Thus, applicants submit that all claims patentably distinguish over this proposed combination of references in the sense of 35 USC 103, and should be considered allowable thereover.

As to new independent claims 14 and 18 and the dependent claims thereof, applicants note that as indicated above, claims 14 and 18 recite features somewhat similar to claim 4 although, in some instances more broadly reciting some of the

features, and in other instances, reciting additional features. Irrespective of such features, applicants submit that Crue et al taken alone or in combination with the other cited art provide no disclosure or teaching of the recited features of claims 14 and 18 and the dependent claims in the sense of 35 USC 103 and applicants submit that such claims should also be considered allowable over this cited art in the sense of 35 USC 103.

As noted above, applicants consider an interview with the Examiner to be appropriate prior to the Examiner acting on this application and applicants request the Examiner to contact the undersigned to schedule the same.

For the foregoing reasons, applicants submit that all claims present in this application should now be in condition for allowance and issuance of an action of a favorable nature is courteously solicited.

To the extent necessary, applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to the deposit account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (Case: 500.37488CC5), and please credit any excess fees to such deposit account.

Respectfully submitted,

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